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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
MOLINARI, MICHAEL J

ART UNIT	PAPER NUMBER
2665	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 January 2004</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-36</u> is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
  application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claim 35 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 35 repeats a plurality of limitations contained in claim 32, from which it depends.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claim 2 recites the limitation "the offeree's computer system". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-3, 5-9 13-18, 20-23 and 27-36 are rejected under 35 U.S.C. 102(e) as being

anticipated by Weinstein et al. (U.S. Patent Application Publication US 2001/0026609 A1).

3.   Referring to claim 1, Weinstein et al. disclose a computer system comprising: a storage

medium (Memory, see paragraph 0082) having stored therein a plurality of programming

instructions to implement a set of communication services on the computer system for generating

on behalf of an offeror (Mary) client, an electronic token (Link, see paragraph 0061) representing

an offer to participate in a voice call with a destination party designated by the offeror client (see

paragraph 0055, lines 1-3 and see paragraph 0061), the electronic token to be transmitted by the

offeror client in association with an electronic mail message to an offeree (John) (see paragraph

0055, lines 1-3), services for receiving on behalf of the offeror client (Mary), through a data

network link (via email), a notification from the offeree denoting the offeree's acceptance of the

offeror client's offer by activating said electronic token (see paragraph 0067), and services for

causing, immediately (For example, if Mary sets the available times to call for any time, as

shown in paragraph 0066) in response to the offeree's acceptance of the offeror client's offer

(see paragraph 0009), a first voice call connection to be initiated to the destination party

designated by the offeror client and a second voice call connection to be initiated to the offeree,

and bridging together the two connections so as to establish a voice call between the destination

party and the offeree (see paragraph 0008, lines 4-6, paragraph 0068 and Figures 8 and 9); and

an execution unit (CPU, see paragraph 0082) coupled to the storage medium for executing the

plurality of programming instructions.

4.   Referring to claim 2, Weinstein et al. disclose that the offeree accepts the offeror client's

offer by activating the electronic token displayed on the offeree's computer system (see

paragraph 0061).

5.   Referring to claim 3, Weinstein et al. disclose that activating the electronic token

comprises selecting the electronic token with a user input device (see paragraph 0061).

6.   Referring to claim 5, Weinstein et al. disclose that the electronic token comprises a URL

(see paragraph 0061).

7.   Referring to claim 6, Weinstein et al. disclose that the voice call comprises at least one of

a circuit switched call and a packet based call (see Figure 8 and paragraph 0085).

8.   Referring to claim 8, Weinstein et al. disclose that the destination party designated by the

offeror client is the offeror client (see paragraph 0009).

9.   Referring to claim 9, Weinstein et al. disclose that the first and second voice calls each

comprise a circuit switched call (see Figure 8 and paragraph 0085).

10.   Referring to claim 13, Weinstein et al. disclose that the electronic token is generated on

behalf of the offeror client based at least in part upon data provided to the computer system by

the offeror client (see paragraph 0053), the data associated with at least one of a PSTN extension

corresponding to the destination party designated by the offeror client and a PSTN extension

corresponding to the offeree (see paragraph 0057).

11.   Referring to claim 14, Weinstein et al. disclose that the PSTN extension corresponding to

the offeror client is obscured to prevent the offeree from identifying the PSTN extension

associated with the destination party designated by the offeror client (see paragraphs 0014, 0061,

and 0065-0068).

12.   Referring to claim 15, Weinstein et al. disclose programming instructions to implement

services for receiving payment information from the offeror client in association with at least one

of the first and second calls, and services for verifying the ability of the offeror client to pay an

indicated amount, prior to causing the first and second voice calls to be bridged (see paragraph

0053).

13.   Referring to claim 16, Weinstein et al. disclose a method comprising: transmitting by an

offeror party (Mary) in association with an electronic mail message (see paragraph 0055, lines 1-

3), an electronic token (Link, see paragraph 0061) representing an offer to participate in a voice

call with a destination party (see paragraphs 0055 and 0061); receiving, by an offeree party

(John), the electronic token representing the offer to participate in the voice call with the

destination party (see paragraph 0061, line 1); receiving on behalf of the offeror party, through a

data network link, a notification from the offeree denoting the offeree's acceptance of the offeror

party's offer by activating said electronic token (see paragraph 0067); and causing, immediately

(For example, if Mary sets the available times to call for any time, as shown in paragraph 0066)

in response to the offeree's acceptance of the offeror client's offer (see paragraph 0009), a first

voice call connection to be initiated to the destination party designated by the offeror client and a

second voice call connection to be initiated to the offeree, and bridging together the two

connections so as to establish a voice call between the destination party and the offeree (see

paragraph 0008, lines 4-6, paragraph 0068, and Figures 8 and 9).

14.   Referring to claim 17, Weinstein et al. disclose that the offeree party accepts the offer to

participate in the voice call by activating the electronic token representing the offer (see

paragraph 0061).

15.   Referring to claim 18, Weinstein et al. disclose that activating the electronic token includes selecting the electronic token with a user input device (see paragraph 0061).

16.   Referring to claim 20, Weinstein et al. disclose that the electronic token comprises a URL (see paragraph 0061).

17.   Referring to claim 21, Weinstein et al. disclose that the destination party is the offeror party (see paragraph 0009).

18.   Referring to claim 22, Weinstein et al. disclose that the voice call comprises at least one of a circuit switched call and a packet based call (see Figure 8 and paragraph 0085).

19.   Referring to claim 23, Weinstein et al. disclose that both the first and second voice call connections are PSTN call connections (see Figure 8 and paragraph 0085).

20.   Referring to claim 27, Weinstein et al. disclose that the electronic token is generated by a third party based at least in part upon data provided to the third party by the offeror party in association with a contractual relationship previously established between the third party and the offeror party (see paragraph 0053).

21.   Referring to claim 28, Weinstein et al. disclose that the data provided to the third party by the offeror party includes a first PSTN extension corresponding to the offeree party and a second PSTN extension corresponding to the destination party (see paragraph 0057).

22.   Referring to claim 29, Weinstein et al. disclose that the second PSTN extension is obscured to prevent the offeree party from identifying the second PSTN extension (see paragraphs 0014, 0061, and 0065-0068).

23.   Referring to claim 30, Weinstein et al. disclose that the data provided to the third party includes billing information (see paragraph 0053).

24.   Referring to claim 31, Weinstein et al. disclose that the voice call is bridged only after payment verification is received by the third party from an independent party assuring that the offeror party will pay for the cost of the call (see paragraphs 0053 and 0063).

25.   Referring to claim 32, Weinstein et al. disclose a computer system comprising: a storage medium (Memory, see paragraph 0082) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for receiving on behalf of an offeror (Mary) client, through a data network link (see Figure 8), a notification from an offeree (John) denoting the offeree's acceptance of the offeror client's offer to participate in a voice call with a designated destination party (see paragraphs 0055, lines 1-3, 0061, and 0067), the offer communicated to the offeree by an electronic token (Link, see paragraph 0061) in association with an electronic mail message (see paragraph 0055, lines 1-3), and for causing, immediately (For example, if Mary sets the available times to call for any time, as shown in paragraph 0066) in response to the offeree's acceptance of the offeror client's offer (see paragraph 0009) by activating the electronic token (see paragraph 0061), a first voice call connection to be initiated to the destination party designated by the offeror client and a second voice call connection to be initiated to the offeree, and bridging together the two connections so as to establish a voice call between the destination party and the offeree (see paragraph 0008, lines 4-6, paragraph 0068, and Figures 8 and 9); and an execution unit coupled to the storage medium for executing the plurality of programming instructions (CPU, see paragraph 0082).

26.   Referring to claim 33, Weinstein et al. disclose that the destination party is designated by the offeror (see paragraph 0053).

27.   Referring to claim 35, Weinstein et al. disclose that the services for causing the voice call

to be established between the designated destination party and the offeree, comprise services for

causing a first voice call to be established with the offeree, for causing a second voice call to be

established with the designated destination party, and for causing the first and second voice calls

to be bridged to place the offeree and the designated destination party in voice communication

with each other (see paragraph 0008, lines 4-6, paragraph 0068, and Figures 8 and 9).

28.   Referring to claim 36, Weinstein et al. disclose a computer system comprising: a storage

medium (Memory, see paragraph 0082) having stored therein a plurality of programming

instructions to implement a set of communication services on the computer system for generating

on behalf of an offeror (Mary) client, an electronic token (Link, see paragraph 0061) representing

an offer to participate in a voice call with a designated destination party (see paragraph 0055,

lines 1-3 and see paragraph 0061), the electronic token to be transmitted to an offeree (John) in

association with an electronic mail message (see paragraph 0055, lines 1-3) and services for

causing, immediately (For example, if Mary sets the available times to call for any time, as

shown in paragraph 0066) in response to the offeree's acceptance of the offeror client's offer

(see paragraph 0009) by activating said electronic token (see paragraph 0061), a first voice call

connection to be initiated to the destination party designated by the offeror client and a second

voice call connection to be initiated to the offeree, and bridging together the two connections so

as to establish a voice call between the destination party and the offeree (see paragraph 0008,

lines 4-6, paragraph 0068, and Figures 8 and 9); and an execution unit coupled to the storage

medium for executing the plurality of programming instructions (CPU, see paragraph 0082).

Claim Rejections - 35 USC § 103

29.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

30.   Claims 4, 10-12, 19 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Weinstein et al. (U.S. Patent Application US 2001/0026609 A1).

31.   Referring to claims 4 and 19, Weinstein et al. disclose that the electronic token comprises

a link but differ from claims 4 and 19 in that they fail to disclose that the electronic token

comprises a graphical icon. However, it is old and well known in the art to represent links as

graphical icons to achieve the advantage of improving the appearance of a link. One skilled in

the art would have known of representing links as graphical icons and would have recognized

their advantage. Therefore, it would have been obvious to a person with ordinary skill in the art

at the time of the invention to represent the link as a graphical icon to achieve the advantage of

improving the appearance of the link.

32.   Referring to claims 10-12, Weinstein et al. differ from claims 10-12 in that they fail to

disclose that either of the voice calls could be a packet based call instead of a circuit switched

call. However, it is well known in the art to substitute a packet based call for a circuit switched

call to achieve the advantage of saving money. One skilled in the art would have known of

packet based voice calls and would have recognized their advantage. Therefore, it would have

been obvious to a person with ordinary skill in the art at the time of the invention to incorporate

the use of packet based calls into the invention of Weinstein et al. to achieve the advantage of saving money.

33.   Referring to claims 24-26, Weinstein et al. differ from claims 24-26 in that they fail to disclose that either of the voice call connections could be a VOIP call connection instead of a PSTN call connection. However, it is well known in the art to substitute a VOIP call connection for a PSTN call connection to achieve the advantage of saving money. One skilled in the art would have known of VOIP call connections and would have recognized their advantage. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate the use of VOIP call connections into the invention of Weinstein et al. to achieve the advantage of saving money.

Response to Arguments

34.   Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Molinari whose telephone number is (703) 305-5742. The examiner can normally be reached on Monday-Thursday 8am-6:30pm.
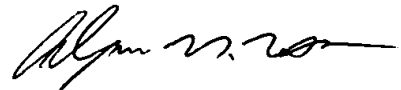
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Joseph Molinari

**ALPUS H. HSU
PRIMARY EXAMINER**